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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,074	06/28/2001	Wayne F. Miller	STL920000094US1	6572

7590 05/28/2004

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/894,074	MILLER ET AL	
	Examiner	Art Unit	
	Hoang-Vu A Nguyen-Ba	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/03/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to application filed June 28, 2001.
2. Claims 1-39 have been examined.

Information Disclosure Statement

3. The Office acknowledges receipt of the IDS filed January 03, 2002. The references listed therein have been considered.

Drawings

4. The drawings filed on June 28, 2001 have been approved by the examiner.

Specification

5. The disclosure is objected to because of the following informalities: the U.S. Patent Application No. of the co-pending and commonly-assigned patent applications is missing.

Appropriate correction is required.

Claim Objections

6. Claims 23, 24 and 37 are objected to because of the following informalities:
Claim 23: at line 5, before "at least one node", replace the term "from" with – with –
Claim 24: at line 3, after "one user performing actions" insert – from – ; and before "node" insert – one –
Claim 37: at line 3, before "node" insert – one –

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2, 15, 27 and 28 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 15 and 28

9. Claims 2, 15 and 28 contains the trademark or trade name "FlowMark." Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the IBM FlowMark product which uses a definition language (.fdl) to define processes in a workflow server environment. Accordingly, the identification/description is indefinite.

Claim 27

10. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

In claim 27, it is unclear whether an article of manufacture or a program code or a process of generating a workflow is claimed. With an article of manufacture recited in the preamble, one would expect to find in the body of the claim means or devices having functions to generate a workflow. However, one only found method steps for generating a workflow.

Correction is required.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claim 27 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

A single claim which claims both an apparatus and the method steps of using the apparatus should also be rejected under 35 U.S.C. 101, *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different

statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Correction is required.

Claim Rejections – 35 U.S.C. § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-39 are rejected under 35 U.S.C. § 102(b) as being anticipated by Boden et al. (“Boden”).

Claims 1, 14 and 27

Boden discloses at least:

displaying a plurality of graphical user interfaces (GUI) panels through which a user is capable of defining nodes of a workflow and associating at least one action and user with each node, wherein the defined associated user performs the associated action at the node when executing the workflow, and wherein multiple nodes define actions that process at least one object that is routed through multiple nodes of the workflow (see at least Figures 10, 11 and related discussion in the specification; 4:55-63);

generating from information entered into the GUI panels a workflow model including the nodes and workflow defined by the user through the GUI panels that

process the at least one object (see at least Figure 12 and related discussion in the specification);

transforming the workflow model into a workflow definition language (WDL) file (see at least Figure 10 and related discussion in the specification); and

transferring the WDL file to a workflow server, wherein the workflow server interacts with a database to implement the workflow model defined in the WDL file in the database (see at least Figure 6, from block 170 to block 120; Figure 7, blocks 121, 111 and related discussion in the specification; 1:46-52).

Claims 2, 15 and 28

The rejection of base claims 1, 14 and 27 respectively is incorporated. Boden further discloses *wherein the workflow definition language (WDL) comprises the FlowMark Definition Language (FDL) (see at least Figure 8, block 110 and related discussion in the specification).*

Claims 3, 16 and 29

The rejection of base claims 1, 14 and 27 respectively is incorporated. Boden further discloses *wherein one displayed GUI panel illustrates a layout of the workflow including graphical representations of nodes and paths between the nodes to enable the user to manipulate instances of the graphical representations of the nodes and paths in the workflow within the GUI panel to design a layout of the nodes of the workflow (see at least Figure 12 and related discussion in the specification).*

Claims 4, 17 and 30

The rejection of base claims 1, 14 and 27 respectively and intervening claims 3, 16 and 29 respectively is incorporated. Boden further discloses *wherein at least one*

graphical representation represents a work node, wherein for each graphical representation of the work node added to the GUI panel, further comprising displaying a GUI panel including fields in which the user associates the at least one user and action with the work node (see at least Figure 12 and related discussion in the specification).

Claims 5, 18 and 31

The rejection of base claims 1, 14 and 27 respectively and intervening claims 3, 16 and 29 respectively is incorporated. Boden further discloses *wherein at least one graphical representation represents a user exit node, wherein for each graphical representation of the user exit node added to the GUI panel, further comprising:*

displaying a GUI panel including fields in which the user associates at least one action to be performed in the background, wherein the workflow proceeds to the next node while the associated at least one background action is performed (see at least Figure 12 and related discussion in the specification).

Claims 6, 19 and 32

The rejection of base claims 1, 14 and 27 respectively and intervening claims 3 and 5, 16 and 18 and 29 and 31, respectively is incorporated. Boden further discloses *wherein the background action comprises a call to an application to perform an action with respect to the object (see at least Figure 12 and related discussion in the specification).*

Claims 7, 20 and 33

The rejection of base claims 1, 14 and 27 respectively is incorporated. Boden does not specifically disclose:

receiving a request by one user associated with one node to access the node when no other user is accessing the node;

granting the user requesting access to the node access to the node to perform the action associated with the node;

locking the node to prevent other users associated with the node from accessing the node; and

releasing the lock on the node when the user granted access to the node completes the action associated with the node, wherein other users can access the node after the lock is released

However, this feature is deemed to be inherent to the IBM FlowMark™ product as 4:66 - 5:35 shows that the number of users authorized to start and control a process can be restricted. Without a locking mechanism, this restriction would be inoperative.

Claims 8, 21 and 34

The rejection of base claims 1, 14 and 27 respectively is incorporated. Boden further discloses *wherein if multiple nodes lead to one node in the workflow, then the workflow server when executing one instance of the workflow only proceeds to the node to which multiple nodes connect when the multiple nodes complete processing* (see at least 5:6-35).

Claims 9, 22 and 35

The rejection of base claims 1, 14 and 27 respectively is incorporated. Boden further discloses *wherein the at least one object routed through the nodes for processing comprises at least one electronic document that is modified by users and routed through the nodes of the workflow* (see at least Figure 3 and related discussion in the specification).

Claims 10, 23 and 36

The rejection of base claims 1, 14 and 27 respectively is incorporated. Boden further discloses *wherein the object processed at the nodes is included in a work packet, wherein the work packet is capable of including multiple objects, further comprising:*

receiving modifications to at least one object in the work packet by one user performing actions associated with one node, wherein multiple users perform actions at different nodes to process objects in the work packet routed through the nodes (see at least Figures 2, 3 and related discussion in the specification).

Claims 11, 24 and 37

The rejection of base claims 1, 14 and 27 respectively and intervening claims 10, 23 and 36 respectively is incorporated. Boden further discloses *receiving at least one additional object to add to the work packet from at least one user performing actions from at least one node, wherein the work packet, including any added objects, is routed through the nodes of the workflow (see at least Figure 2 and related discussion in the specification).*

Claims 12, 25 and 38

The rejection of base claims 1, 14 and 27 respectively and intervening claims 10, 23 and 36 respectively is incorporated. Boden further discloses *wherein the objects in the work packet are capable of comprising documents, images, sound files, video files, and application data (see at least 2:6-57).*

Claims 13, 26 and 39

The rejection of base claims 1, 14 and 27 respectively and intervening claims 10, 23 and 36 respectively is incorporated. Boden further discloses *wherein multiple users at different nodes may concurrently process objects in the work packet (see at least 4:57 – 5:3).*

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Antony Nguyen-Ba, whose telephone number is (703) 305-0103. The examiner can normally be reached on Tuesday - Friday from 6:15 – 3:45 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam, can be reached at (703) 305-4552.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Central Fax Number

(703) 872-9306



**ANTONY NGUYEN-BA
PRIMARY EXAMINER**

Art Unit 2122

May 23, 2004